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EXAMINER	
SHAY, D	
ART UNIT	**PAPER NUMBER**
335	4

DATE MAILED: 02/20/87

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☑ Responsive to communication filed on Oct. 8, 1986 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ——— days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☑ Claims 1-24 are pending in the application.
   Of the above, claims _____ are withdrawn from consideration.
2. ☑ Claims 1-6 and 18-24 and 10 and 11 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☑ Claims 7-9 and 12-17 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to adequately teach how to make the invention, i.e. failing to provide an enabling disclosure.

Applicant's invention involves the interaction of several systems which are highly complex in nature, each with its own control system and protocol. The software program necessary for the coordinated interaction of this group of systems would be a highly complex one and its construction cannot be construed as a simple task. The objection is raised because Applicant has not supplied the program or flow charts to implement the programming of the microprocessor necessary to perform the claimed function.

Claims 7-9 and 12-17 are rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the above objection to the specification.

Claims 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13-15 are indefinite because the term "said last defined means" lacks positive antecedent basis.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 7-9 are rejected under 35 U.S.C. 103 as being unpatentable over Goldman et al in view of Heidary et al, Shah et al and Curtin. Goldman et al teach an ophthalmic laser device which can produce an operating beam in the ultraviolet spectrum. Heidary et al teach a scanning device for a laser cutter which allows rectangular area of scan which can be reduced or increased in size. Shah et al teach multiple area scans. Curtin et al teach an ophthalmological device for recurving the cornea which includes microprocessor control, limiting the recurving area and body engagable means for securing the eye. This merely requires the inclusion in the device of Goldman et al the well-known scanning pattern generator, multiple scan device, and body engagable means as taught by Heidary et al, Shah et al and Curtin, respectively. Hence, it would have been obvious to one

of ordinary skill in the art to combine these old and well-known teachings to produce a device such as claimed.

Claims 12, 13 and 17 are rejected under 35 U.S.C. 103 as being unpatentable over Goldman et al in view of Heidary et al and Davi. The teachings of Goldman et al and Heidary et al are those iterated previously in the rejection of claim 7. Davi teaches excising tissue using a device which employs circular scans and is under microprocessor control and deactivates the beam between scans. This merely requires the substitution of a circular scanning step as taught by Davi into the device of Goldman et al and Heidary et al. Thus, it would have been obvious to one of ordinary skill to combine these old and well-known teachings to produce a device such as claimed.

Claims 14-16 are rejected under 35 U.S.C. 103 as being unpatentable over Goldman et al in view of Heidary et al and Davi as applied to claim 12 above, and further in view of Karp. Karp teaches producing circular cuts in the cornea which can be solid or broken lines. This merely requires the inclusion of a further step of deactivating the laser while the device is making a circular cut. Hence, it would have been obvious to the ordinarily skilled artisan to combine these old and well-known teachings to produce a device such as claimed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Waring teaches the ineffectiveness of circular cuts in keratotomy procedures.

Any inquiry concerning this communication should be directed to David Shay at telephone number 703-557-3125.

D. Shay:ch
2/17/87

LEE S. COHEN
PRIMARY EXAMINER
GROUP ART UNIT 335